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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/066,143	01/31/2002	Lonnie W. Adelman	10012205 -1	3546

7590 11/12/2004
HEWLETT-PACKARD COMPANY
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EXAMINER

DANG, KHANH

ART UNIT PAPER NUMBER

2111

DATE MAILED: 11/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/066,143

Applicant(s)

ADELMAN, LONNIE W.

Examiner

Khanh Dang

Art Unit

2111

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34, 36-38 and 41-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34, 36-38, 41-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

Claims 25, and 33, 34, 36-38, 41-45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 25 is directed to an apparatus. However the essential structural cooperative relationship(s) between the so-called "means for monitoring" and "means for generating" have been omitted, such omission amounting to a gap between necessary structural connections. See MPEP § 2172.01.

Claim 33 is indefinite. The phrase "where the data relates to a condition not included in the network protocols" renders the claim indefinite.

Claim 38 is indefinite. The phrase "for monitoring a condition of an appliance not included in the operating protocols" renders the claim indefinite.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-34, 36-38, 41-45 are rejected under 35 U.S.C. 102(e) as being anticipated by Maeda.

At the outset, it is noted that similar claims will be grouped together to avoid repetition.

As broadly drafted, these claims do not define any structure/step that differs from Maeda.

With regard to claims 1, 8, 13, 21, 25, 33, 34, 38, 41, Maeda discloses system for use with an electronic appliance configurable for use with an IEEE 1394 serial bus, comprising: an IEEE 1394 compliant electrical device (100); and, a circuit (included in PC 102/402) electronically coupled with said electrical device (100) and configured to cause a reset signal to be generated when a power status of the electronic appliance changes (stop and start power supply or change in voltage/power level will cause a reset signal to be generated); wherein said electrical device (100) and said circuit (included in PC 102/402) are configured to be coupled with the IEEE 1394 serial bus (see at least column 1, line 44) and the electronic appliance (100).

With regard to claim 2, it is clear that the electrical device of Maeda, as in any digital device, comprises an integrated circuit.

With regard to claim 3, 16, 22-24, 36, 42, it is clear that the 1394 system of Maeda must be in full compliance with IEEE 1394 specification. Thus, in Maeda, the electrical device (100) controls a physical layer and the reset signal causes the physical layer and the network (IEEE 1394 network shown generally at Fig. 1) to be reset. See

Art Unit: 2111

also Applicant's own acknowledgement, page 3, line 1 to page 4, line 24; page 9, lines 14-22; page 10, line 18 to page 12, line 10.

With regard to claims 4, 17, 18, 37, 43, it is clear that the 1394 system of Maeda must be in full compliance with IEEE 1394 specification. Thus, in Maeda, the reset of the physical layer causes a self-ID command to be generated on the IEEE 1394 serial bus. See also Applicant's own acknowledgement, page 3, line 1 to page 4, line 24; page 9, lines 14-22; page 10, line 18 to page 12, line 10.

With regard to claim 5, it is clear that the 1394 system of Maeda must be in full compliance with IEEE 1394 specification. Thus, in Maeda, the electrical device controls a link layer. See also Applicant's own acknowledgement, page 3, line 1 to page 4, line 24; page 9, lines 14-22; page 10, line 18 to page 12, line 10.

With regard to claims 6, 12, 19, 44, it is clear that the 1394 system of Maeda must be in full compliance with IEEE 1394 specification. Thus, in Maeda, the self-ID command includes a status of the link layer. See also Applicant's own acknowledgement, page 3, line 1 to page 4, line 24; page 9, lines 14-22; page 10, line 18 to page 12, line 10.

With regard to claims 7, 11, 14, 15, it is clear that the circuit of Maeda, as in any digital circuit, comprises an integrated circuit.

With regard to claims 9, 45, it is clear that the PC 102/402 comprises digital circuit or "logic circuit." See also column 6, lines 12-26.

With regard to claim 10, it is clear that the circuit of Maeda comprises at least an interface circuit.

With regard to claim 20, it is clear that the 1394 system of Maeda must be in full compliance with IEEE 1394 specification. Thus, in Maeda, the physical layer receives power from a supply source through the 1394 bus. See also Applicant's own acknowledgement, page 3, line 1 to page 4, line 24; page 9, lines 14-22; page 10, line 18 to page 12, line 10.

With regard to claims 26-32, it is clear that one using the apparatus of Maeda would have performed the same steps set forth in claims 26-32. See discussion regarding to the apparatus claims 1-25, 33, 34, 36-38, 41-45.

Response to Arguments

Applicants' arguments filed 9/30/2004 have been fully considered but they are not persuasive.

At the outset, Applicants are reminded that claims subject to examination will be given their broadest reasonable interpretation consistent with the specification. *In re Morris*, 127 F.3d 1048, 1054-55 (Fed. Cir. 1997). In fact, the "examiner has the duty of police claim language by giving it the broadest reasonable interpretation." *Springs Window Fashions LP v. Novo Industries, L.P.*, 65 USPQ2d 1862, 1830, (Fed. Cir. 2003). Applicants are also reminded that claimed subject matter not the specification, is the measure of the invention. Disclosure contained in the specification cannot be read into the claims for the purpose of avoiding the prior art. *In re Sporck*, 55 CCPA 743, 386 F.2d, 155 USPQ 687 (1986).

With this in mind, the discussion will focus on how the terms and relationships thereof in the claims are met by the references. Response to any limitations that are not in the claims or any arguments that are irrelevant and/or do not relate to any specific claim language will not be warranted.

The 112 Rejection:

Applicants argue that "it is not essential to a patentable combination that there be interdependency between the elements of the claimed." MPEP 2172.01 is provided for support. However, such language cannot be found in MPEP 2172.01.

The MPEP 2172.01 is reproduced below:

2172.01 Unclaimed Essential Matter

A claim which omits matter disclosed to be essential to the invention as described in the specification or in other statements of record may be rejected under 35 U.S.C. 112, first paragraph, as not enabling. In re Mayhew, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). See also MPEP Section 2164.08(c). Such essential matter may include missing elements, steps or necessary structural cooperative relationships of elements described by the applicant(s) as necessary to practice the invention.

In addition, a claim which fails to interrelate essential elements of the invention as defined by applicant(s) in the specification may be rejected under 35 U.S.C. 112, second paragraph, for failure to point out and distinctly claim the invention. See In re

Art Unit: 2111

Venezia, 530 F.2d 956, 189 USPQ 149 (CCPA 1976); In re Collier, 397 F.2d 1003, 158 USPQ 266 (CCPA 1968).

MPEP 2172.01 clearly states that "a claim which fails to interrelate (emphasis added) essential elements of the invention as defined by applicant(s) in the specification may be rejected under 35 U.S.C. 112, second paragraph, for failure to point out and distinctly claim the invention. See In re Venezia, 530 F.2d 956, 189 USPQ 149 (CCPA 1976); In re Collier, 397 F.2d 1003, 158 USPQ 266 (CCPA 1968). It is clear that various recited elements function simultaneously, are directly functionally related, directly intercooperate, and/or serve independent purposes. If Applicants disagree Applicants must provide evidence that various recited elements do not function simultaneously, are not directly functionally related, do not directly intercooperate, and/or do not serve independent purposes; and state on the record that this is the case.

With regard to claims 33 and 38, the amendments to claims 33 and 38 do not overcome the issue of indefiniteness.

Claim 33 is indefinite. The phrase "where the data relates to a condition not included in the network protocols" renders the claim indefinite.

Claim 38 is indefinite. The phrase "for monitoring a condition of an appliance not included in the operating protocols" renders the claim indefinite.

The 102 Rejection:

With regard to claim 1, Applicants argue that Meada does not disclose that the reset signal is generated when the power supply status changes. Contrary to Applicants' argument, at the outset, it is noted that according to the IEEE1394, a reset signal is generated whenever power is turned ON for enumerating/polling all devices that are connected to the 1394 network. The mere fact that power changes from OFF to ON indicates that "power supply status changes." In any event, in Meada, when the device 100 is disconnected from or connected to the network, the PC 102 issues the reset command. Receiving the reset command, the printer determines in step 701 whether the reset is the power-on reset. See column 7, line 67 to column 8, line 5. Further, Meada discloses that in order to make a host computer automatically recognize a composite apparatus used with switching between functions thereof, the host 102 recognized whether a device is connected, based on a potential of cable data. With switching between the functions of the apparatus, the device 100 temporarily stops supply of power to the cable data and restart the supply a predetermined time thereafter by R controller 205. When the supply of power is stopped, the host 102 assumes that the device is disconnected and deletes a driver for the device from a memory. When the supply of power is restarted thereafter, the host 102 recognizes the device 100 as a device having a new function, reads device information, and installs a driver suitable for the new device. Note that a reset signal, according to the IEEE 1394 is always generated to enable enumerating/polling all devices that are connected to the 1394 network whenever the power supply is stopped and started gain. See the abstract. As a matter of fact, Maeda discloses that when the

Art Unit: 2111

timer 204 is started by the pulse signal, the timer 204 controls the R controller 205 to stop the power supply to the resistor R3. After counting the time T_2+T_3 shown in FIG. 5C, the timer restarts the power supply. As a consequence, the PC 102 recognizes as if the device disconnection and connection operations are carried out with an interval of the time T_3+T_1 , though the cable is kept in connection on the network. The processes of disconnection and connection of the device 100 are executed in this way. With detachment of the device 100, the PC 102 uninstalls the driver for the device 100 from the PC 102. Subsequently, the PC 102 recognizes as if the device 100 is newly connected on the network. Therefore, the PC 102 sends a reset signal to the new device 100 and starts the processing including the process of reading the information according to the predetermined protocol. See at least column 7, lines 50-65. With regard to claims 30, 33 and 38, Applicants argue that Maeda does not disclose "the condition relating to an ability of the appliance to receive and transmit data over the network" Contrary to Applicants' argument, it is clear that in Maeda, monitoring a connection/disconnection condition of a device in a network is monitoring the condition relating to an ability of a device to receive and transmit data over the network.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

Art Unit: 2111

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Khanh Dang at telephone number 703-308-0211.



Khanh Dang
Primary Examiner